



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/729,999 | 12/09/2003 | M. Alain Cadic | 025200-042 | 3905 |
| 21839 | 7590 | 05/04/2005 | EXAMINER | |
| BURNS DOANE SWECKER & MATHIS L L P | | | PARA, ANNETTE H | |
| POST OFFICE BOX 1404 | | | ART UNIT | |
| ALEXANDRIA, VA 22313-1404 | | | PAPER NUMBER | |

1661

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

| | | | |
|---|-------------|---|---------------------|
| APPLICATION NO./ CONTROL NO. <i>id 729 999</i> | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
|---|-------------|---|---------------------|

EXAMINER

ART UNIT

PAPER

04192005

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Rule 105 Requirement for Information

The claimed caryopteris plant cultivar Inoveris is described in the following Plant Breeder's Rights (PBR):

French application number 3000234 published on June 10, 1998, more than one-year prior to filing date of this instant application.

Given this information, the applications, grants, and denomination are printed publications under the guidelines set forth in *In re Wyer*. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. The Applicant admits that 'Inoveris' was publicly available in France as early as July 1999 (page 4 of reply filed August 26, 2002). . The Plant Breeder's Right applications, grants and denomination are enabled because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re Le Grice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could obtain or reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications.").

The publication cited above discloses the claimed variety and Applicant admits that the public availability of the plant as early as July 1999. However, a question remains as to the accessibility of the foreign sales of the claimed plant, the reproducibility of the claimed plant and whether one of ordinary skill in the art would have known of the foreign sale. The foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art.

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine the accessibility of the foreign sales and the reproducibility of the plants that were sold to the public, more than one year prior to the effective filing date of this application.

14

In response to this requirement please provide:

- a) a copy of any publications or advertisements relating to sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world if the sale, offer for sale, or public distribution occurred more than one year prior to the filing date of this application;
- b) any public information available regarding sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world that occurred more than one year prior to the filing date of this application, including the date(s) and location(s) as well as information pertaining to whether this was an obscure, solitary occurrence that would go unnoticed by those skilled in the art;
- c) any information relating to the accessibility or non-accessibility of the claimed plant that one of ordinary skill in the art could have derived from the printed PBR document;
- d) Applicant is also invited to submit any information that would indicate that one of ordinary skill in the art would not have known how to successfully reproduce the plant.

It is reasonable to expect that Applicant or the assignee can readily obtain the requested documents and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. If an item required by the examiner is unknown to the applicant, a statement that the item is unknown to applicant will be accepted as a complete response to the requirement for that item. Where the applicant does not have and cannot readily obtain an item of required information, a statement that the item cannot be readily obtained will be accepted as a complete response to the requirement for that item.

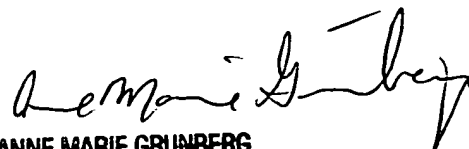
This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (571) 272-0982. The Examiner can normally be reached Monday through Thursday from 5:30 am to 4:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax numbers for the group is (571) 273-8300. The Technology Center phone number is (571) 272-1600. Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 872-9305.

A.H.P


ANNE MARIE GRUNBERG
PRIMARY EXAMINER